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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,726	08/05/2003	Paul L. Jeran	10982225-2	8866

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Intellectual Property Administration
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EXAMINER

WALLERSON, MARK E

ART UNIT	PAPER NUMBER
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2625

DATE MAILED: 04/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

SUPPLEMENTAL
Office Action Summary

Application No.

10/635,726

Applicant(s)

JERAN ET AL.

Examiner

Mark E. Wallerson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 21-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 21-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date 8/5/2003.

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Part III DETAILED ACTION

Notice to Applicant(s)

1. This application has been examined. Claims 1-15 and 21-35 are pending.

Information Disclosure Statement

2. The references listed in the Information Disclosure Statement dated 8/5/2003 have been considered by the Examiner and is attached to this Office Action.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 6, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 34, and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolff et al (Wolff) (U.S. 5,671,282).

With respect to claims 1, 6, 27, 29, 31, and 32, Wolff discloses a method of document management, comprising providing a document comprising an original document (column 3, lines 27-34); scanning the document with a scanning machine configured to determine if the original document has a machine-readable code thereon (column 5, lines 5-24), the scanning machine being further configured to extract at least some information from the machine-readable code if the machine readable code is present on the document (column 5, lines 4-24); providing a database of information (which reads on the storage of the electronic version of the document)

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that can be present in the machine- readable code on the original document, the providing the database of information comprising providing before the scanning (column 3, lines 41-50 and column 3, line 65 to column 4, line 15), and comparing at least some of any information extracted from the machine- readable code by the scanning machine with the information in the database to track the document (column 3, lines 43-64).

Further with respect to claim 29, Wolff discloses storing a digital representation of the scanned version of the document together with digital representations of other versions of the document using the database (column 5, lines 32-44); and determining that the digital representations of the other versions of the document are in the database (column 5, lines 32-43).

With regard to claim 2, Wolff discloses printing the document with a printing device which prints the machine-readable code on the document, and wherein the printing device is in data communication with the database (column 4, lines 16-34).

With respect to claim 21, Wolff discloses 21 the information contained in the machine-readable code defines a version of the document (column 5, lines 50-51) and the scanning comprises scanning a scanned version of the document (column 5, lines 4-24), and further comprising: storing a digital representation of the scanned version of the document together with digital representations of other versions of the document using the database (column 5, lines 32-44); and determining that the digital representations of the other versions of the document are in the database (column 5, lines 32-43).

With regard to claims 22, 23, and 26, Wolff discloses providing a hard image formed on output media (column 3, lines 27-34).

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With respect to claims 24 and 34, Wolff discloses the scanning machine is linked with a processor (101B) that is in data communication with the database (101A) and in data communication with a second printer (101D), the processor being configured to enable either the scanned version of the document or one of the other versions of the document stored in the database as digital representations to be printed by the second printer (column 3, line 35 to column 4, line 34).

With respect to claim 25, Wolff discloses printing the machine generated code as the document is generated (column 3, lines 27-50).

With regard to claim 28, Wolff discloses storing the machine readable code as the additional information in the database (column 3, lines 35-50).

With respect to claims 30 and 35, Wolff discloses imaging the document after determining (column 4, lines 16-28).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 4, 5, 7, 8, 9, 10, 12, 13, 14, 15, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff in view of Ikenoue et al (Ikenoue) (U.S. 5,987,127).

With respect to claims 3, 4, 7, 8, 9, and 33, Wolff differs from claims 3, 4, 7, 8, 9, and 33, in that he does not clearly disclose wherein the scanning machine is linked with a copying

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machine configured for copying the document, wherein the information contained in the machine-readable code defines if the document can be copied, and wherein the copier is configured to copy the document unless the scanning machine finds the machine-readable code on the document and extracts information from the machine-readable code not authorizing the copying.

Ikenoue discloses an image forming apparatus and copy management system wherein a scanning machine is linked with a copying machine configured for copying a document, wherein the information contained in machine-readable code defines if the document can be copied, and wherein the copier is configured to copy the document unless the scanning machine finds the machine-readable code on the document and extracts information from the machine-readable code not authorizing the copying (column 2, lines 45-56; column 10, lines 24-67, and column 11, lines 35-48). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Wolff wherein the information contained in machine-readable code defines if the document can be copied, and wherein the copier is configured to copy the document unless the scanning machine finds the machine-readable code on the document and extracts information from the machine-readable code not authorizing the copying. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Wolff by the teaching of Ikenoue in order to prevent illegal copying as disclosed by Ikenoue in column 1, lines 12-15.

With regard to claim 5, Wolff discloses the information included in the machine-readable code includes a storage location (address) of a file (column 5, lines 50-63).

With respect to claim 10, Wolff discloses the machine-readable code is printed with at least one of a resolution or tonal (density) difference that cannot be reproduced by the second copying machine (column 8, lines 18-36).

With regard to claims 12, 13, and 14, Wolff discloses printing the code on copies of the document (column 4, lines 16-34).

With respect to claim 15, Wolff differs from claim 15 in that he does not clearly disclose the second copying machine is configured to identify a user requesting a copy of the document, wherein the information contained in the machine-readable code defines if the document can be copied by particular users, and wherein the second copying machine is configured to not copy the document unless the scanning machine finds the machine-readable code and extracts information from the code authorizing copying by an identified user.

Ikenoue discloses identifying a user requesting a copy of the document, wherein the information contained in the machine-readable code defines if the document can be copied by particular users, and wherein the second copying machine is configured to not copy the document unless the scanning machine finds the machine-readable code and extracts information from the code authorizing copying by an identified user (column 2, lines 46-56). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Wolff wherein the information contained in the machine-readable code defines if the document can be copied by particular users, and wherein the second copying machine is configured to not copy the document unless the scanning machine finds the machine-readable code and extracts information from the code authorizing copying by an identified user. It would

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have been obvious to one of ordinary skill in the art at the time of the invention to have modified Wolff by the teaching of Ikenoue in order to prevent illegal copying.

7. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wolff in view of Ikenoue as applied to claim 9 above, and further in view of Jeran et al (Jeran) (U.S. 6,628,412).

With respect to claim 11, Wolff as modified differs from claim 11 in that he does not clearly disclose the machine-readable code is printed with an ink that is not visible when viewed with only light in the visible wavelength range, said ink becoming visible when stimulated with light outside of the visible wavelength range.

Jeran discloses a document management method machine-readable code is printed with an ink that is not visible when viewed with only light in the visible wavelength range, said ink becoming visible when stimulated with light outside of the visible wavelength range (column 3, lines 9-25). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Wolff as modified wherein the machine-readable code is printed with an ink that is not visible when viewed with only light in the visible wavelength range, said ink becoming visible when stimulated with light outside of the visible wavelength range. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Wolff as modified by the teaching of Jeran in order to easily hide the machine readable image as disclosed by Jeran in column 3, lines 3-5.

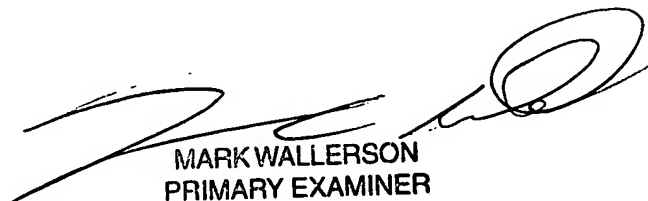
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (571) 272-7470. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark E. Wallerson
Primary Examiner
Art Unit 2626



MARK WALLERSON
PRIMARY EXAMINER